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Paper No. 6

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AUG 15 2002

In re Application of	:	OFFICE OF PETITIONS
Clark et al.	:	
Application No. 10/039,311	:	DECISION GRANTING
Filed: October 26, 2001	:	PETITION
Attorney Docket No. 70625	:	

This is a decision on the petition filed June 4, 2002, to establish that page 57 of the specification was part of the originally filed application. This is also a decision on the petition under 37 CFR 1.47(a) filed October 26, 2001.

The petition under 37 CFR 1.53 to accept page 57 is **granted**.

The petition under 37 CFR 1.47 is **dismissed**.

The petition under 37 CFR 1.53

On October 26, 2001, the application was filed.

On April 1, 2002, the Office of Initial Patent Examination mailed a "Notice of Omitted Item(s)" stating that the application had been accorded a filing date of October 26, 2001, and advising applicants that page 57 of the specification appeared to have been omitted.

In response, the present petition was filed alleging that page 57 was deposited on October 26, 2001. In support, petitioner has submitted a postcard receipt which acknowledges receipt of "Specification and 37 claims (62 pages)" on October 26, 2001.¹ Petitioner has also submitted a copy of the missing documentation- page 57 of the specification.

Upon review of the record, page 57, deposited on October 26, 2001, has not been located. However, the evidence is convincing that the application papers deposited on October 26, 2001, included page 57, and that page 57 was subsequently misplaced in the PTO.

In view of the above, the petition is granted. The copy of page 57 submitted with the petition will be used for examination purposes.

No petition fee is required and none has been charged.

¹ Evidence of receipt of any correspondence filed in the Patent and Trademark Office can be obtained by submitting a self addressed post card properly itemizing and identifying the paper or papers being filed. Upon receipt of the correspondence, the Patent and Trademark Office will check the listing on the post card against the papers submitted, making sure that all items listed are present and will then stamp the postcard with an Official date stamp and place the post card in the outgoing mail. "A post card receipt which itemizes and properly identifies the papers which are being filed serves as *prima facie* evidence of receipt in the PTO of all items listed thereon by the PTO." M.P.E.P. § 503.

The Notice mailed April 1, 2002, was sent in error and is hereby vacated.

Upon the granting of a petition under 37 CFR 1.47, the Application will be returned to the Office of Initial Patent Examination for further processing with a filing date of October 26, 2001, using the application papers filed on October 26, 2001, and the copy of page 57 of the specification filed on June 4, 2002.

The petition under 37 CFR 1.47

The petition under 37 CFR 1.47 is dismissed.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. Any response should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)" and may include an oath or declaration executed by the inventor. **Failure to respond will result in abandonment of the application.**

A grantable petition under 37 CFR 1.47(a) requires

- (1) proof that the non-signing inventor cannot be found or reached after diligent effort or that the inventor refuses to sign after having been presented with the application papers (specification, claims, and drawings),
- (2) a proper oath or Declaration executed by the available joint inventor(s),
- (3) the fee of \$130 as specified in 37 CFR § 1.17(h), and
- (4) the last known address of the omitted inventor(s).

In addition to the above requirements, the signing inventors must sign the declaration on behalf of the non-signing inventor. See MPEP 409.03(a).

The instant petition fails to satisfy (1).

As to item (1), petitioner must establish that the non-signing inventor refused to sign the oath or declaration after being presented with the application papers. Petitioner has failed to establish that the non-signing inventor was presented with a copy of the application. An inventor cannot sign a declaration stating he or she has "reviewed and understands the application papers" when the inventor has not been presented with a copy of the application and therefore has not reviewed the application. Refusal within the meaning of 37 CFR 1.47 requires that the inventor be presented² with the application papers and given adequate time to review the contents of the application. Until the inventor reviews the papers and reads the specification and claims, he cannot know if he is actually an inventor of the claimed invention. Petitioner should send a copy of the application to the inventor along with instructions setting a deadline or a statement that no response will constitute a refusal. This sort of ultimatum lends support to a finding of refusal by conduct.

The petition fee of \$130 was charged to petitioner's deposit account on June 7, 2002.

In order to expedite consideration, petitioner may wish to submit the renewed petition under 37 CFR 1.47 by facsimile transmission to the telephone number indicated below and to the attention of the undersigned.

Petitioner should note that ambiguity seems to exist in regards to parent application no. 09/326,128. The petition in the instant file seems like it may be addressed to the parent

² It is not sufficient for an applicant to simply make the papers available. See MPEP, Section 409.03(d).

application and not the instant application. A review of office computer records fails to indicate that a Rule 47 petition has been filed in the parent application even though such review indicates that a petition fee of \$130 has been received for the parent application. Review of Office computer records indicates that the parent application is currently pending. If an oath or declaration signed by all of the inventors has been filed in the parent application, then petitioner may simply file a copy of such oath or declaration as a part of the instant application. If a petition under 37 CFR 1.47 was filed and granted in the parent application, and such papers were not entered into the computer system, then petitioner may simply file a copy of the decision as a part of the child application. If petitioner has filed a petition under 37 CFR 1.47 in the parent application, but has not received a decision, then petitioner may wish to send a copy of the petition, and any desired supplement to the petition, by facsimile transmission to the Office of Petitions at 703-308-6916, so that the Office of Petitions may consider the merits of the petition.

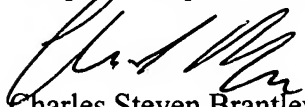
Further correspondence with respect to this matter should be addressed as follows:

By mail: Commissioner for Patents
Box DAC
Washington, D.C. 20231

By facsimile: (703) 308-6916
Attn: Office of Petitions

By hand: Office of Petitions
2201 South Clark Place
Crystal Plaza 4, Suite 3C23
Arlington, VA 22202

Telephone inquiries should be directed to Petitions Attorney Steven Brantley at (703) 306-5683.



Charles Steven Brantley
Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy